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09/921,542	08/03/2001	Daniel L. Schwarz	P-5204	6838
26253	7590	12/27/2005	EXAMINER	
DAVID W. HIGHET, VP AND CHIEF IP COUNSEL BECTON, DICKINSON AND COMPANY 1 BECTON DRIVE, MC 110 FRANKLIN LAKES, NJ 07417-1880			SORKIN, DAVID L	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/921,542
Filing Date: August 03, 2001
Appellant(s): SCHWARZ ET AL.

MAILED

DEC 27 2005

GROUP 1700

Mark Lindsey
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 17 October 2005 appealing from the Office action mailed 15 March 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2,974,018	McNeilly	3-1961
US 2002/0118594	Vellinger et al.	8-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4 and 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by McNeilly (US 2,974,018). Regarding claim 1, McNeilly ('018) discloses a system comprising a sample vessel (46), which is in the form of a sample vial; a panel (68) containing an opening, a stirrer (50) within said sample vessel, wherein said stirrer includes a ferrous metal (see col. 2, lines 59-64); a magnet driver (72,76), adapted to move a magnet (for example 74) proximate to an outer surface of said sample vessel to permit said magnet to impose a magnetic influence on said ferrous metal in said stirrer to move said stirrer in said sample vessel, and wherein said magnet rotates about an axis 90 degrees with respect to the longitudinal axis of said sample vessel (see Fig. 3). Claim 1 refers to "said openings [being] tilted with respect to the horizontal such that said sample vessels when held in said opening are tilted at an angle substantially less than 90 degrees with respect to the horizontal". However, the references to "the horizontal" do not establish orientation with respect to a claimed element, but instead "horizontal" is (based upon the dictionary definitions applicant cites in applicants 04 March 2005 remarks) an orientation relative to the horizon (which in turn is defined by the surface of the Earth or potentially an outer space body such as the Moon, Mars etc.). Therefore, apparatus claim 1 is anticipated if the prior art device is *capable* of satisfying the intended orientation with respect the unclaimed element. If for example "supports 12" of the device of McNeilly ('018) were placed upon a sloped surface, the intended orientation of the opening and vessel would be achieved. In summary

McNeilly ('018) discloses all the positively recited structural elements of claim 1 and would be capable of being operated and oriented in the manner recited in the claim. Regarding claim 2, said magnet driver comprises a magnet shaft assembly (76) having said magnet coupled thereto; and a motor (72), adapted to move said magnet shaft assembly to move said magnet proximate to said outer surface and away from said outer surface. Regarding claim 3, the shaft assembly (76) is rotatable and said motor (72) is capable of performing the act discussed in claim 3. Regarding claim 4, the reference discloses an electric motor which intrinsically involves magnetic coupling to the shaft. Claims 6, 7, 9 and 10 further discuss what the claimed device is intend to do; however, "apparatus claims cover what a device *is*, not what a device *does*" (emphasis in original) *Hewlett-Packard Co. v. Bausch & Lomb Inc.* 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Claim 8 only discusses a magnet which is not recited as part of the claimed apparatus and therefore does not further structurally limit the claimed apparatus.

(10) Response to Argument

Independent claim 1 (pages 3-4 of the brief):

Appellant states on page 4 of the brief that "The examiner has refused to give patentable weight to the term 'horizontal' in claim 1, stating among other things, that the term is merely an intended use". Applicant, in the response filed 04 March 2005, cited two dictionary definitions defining "horizontal" as "parallel to the horizon". The examiner acknowledged this definition in the Final Rejection and is in complete agreement with appellant on the meaning "horizontal". However,

a. The “horizon” is not an element of the claimed structure nor is it geometrically defined by an element or elements of the claimed structure. The “horizon” is an aspect of the Earth or alternatively another celestial body such as the Moon, Mars etc., none of which are required elements of the claimed structure.

b. Recitation of the orientation of the a claimed structure with respect to a something that is not part of the claimed structure is a use of the claimed structure and does not structurally limit that which is being claimed. Certainly, “the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself” *In re Casey*, 152 USPQ 235 (CCPA 1967) and “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

c. Simply placing the prior art apparatus of McNeilly ('018) on a non-level surface would satisfy the “substantially less than 90 degrees with respect to the horizontal” recitation of claim 1. Shipping or otherwise moving the McNeilly device in a non-vertical orientation would satisfy the recitation. Even if you placed the McNeilly device on a moving truck in the vertical orientation, and the truck had to go up a hill, the “substantially less than 90 degrees with respect to the horizontal” recitation of claim 1 would be satisfied. As explained in *In re Schreiber* 44 USPQ2d 1429 (CA FC 1997), if the prior art device is capable of being used in a manner which satisfies the recitations of an apparatus claim, the claim is anticipated.

It should be noted that the examiner offered (see interview summary mailed 01 September 2005) to allow the application if the orientation of the openings relative to the "panel" was recited, rather than relative to the horizontal. However, applicant declined, insisting that "the key element really is the tilting with respect to horizontal to get the air/liquid interface".

Published patent application US 2002/0118594, associated with a NASA sponsorship, is cited to show the significance of magnetic mixers in outer space situations, where no "horizon" is defined. This extreme example makes overwhelmingly clear that orientation of a device relative to the horizon is a use, not a structural limitation concerning the device itself.

Dependent claim 2 (page 4 of the brief):

Appellant states that "McNeilly fails to disclose ... a motor and magnet shaft assembly which moves a magnet toward and away from the outer surface of the sample vessel" (emphasis in original). The claim limitation actually reads "a motor, adapted to move said magnet shaft assembly to move said magnet proximate to said outer surface of said sample vessel and away from said outer surface of said sample". However, "apparatus claims cover what a device *is*, not what a device *does*" (emphasis in original) *Hewlett-Packard v. Bausch & Lomb Inc.* 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). So long as the motor (72) of the prior would be capable of moving the magnet shaft assembly such that the magnet shaft assembly would be capable of moving the magnet toward and away from the vessel the claim is anticipated. Structurally, the motor of the

prior art is exactly the same as that of the instant invention. Both are electric motors having rotating output shafts. While it may be true that McNeilly fails to disclose a step of moving the magnet toward and away from the vessel, one should not say that the motor of McNeilly is incapable of doing so. As explained in *In re Schreiber* 44 USPQ2d 1429 (CA FC 1997): “A patent applicant is free to recite features of an apparatus structurally or functionally.[] Yet, choosing to define an element functionally, i.e., by what it does, carries with it a risk. As our predecessor court stated in *Swinehart*, 439 F.2d at 213, 169 USPQ at 228: where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied upon”.

Dependent claim 7 (pages 4-5 of the brief):

It should be remembered regarding claim 7, that the “magnet” is not positively recited as part of the claimed apparatus. The claim recites a capability of the “driver”. Both the driver of the instant invention and the prior art are the same: both are an electric motor with rotatable shaft. In both, the shaft is oriented perpendicular to the vessel axis. While the magnets of the invention may be positioned differently than those of McNeilly, claim 7 does not require a magnet at all.

Dependent claim 9 (page 5 of the brief):

The panel of McNeilly clearly receives at least two vessels, (44 and 46).

Nonetheless, it should be remembered that claim 9 does not require plural vessels, only a capability to receive plural vessels.

Dependent claim 10 (page 5 of the brief):

The examiner agrees that McNeilly does not disclose a step of orienting the vessel at the claimed angle with respect to the horizon. The issue for this dependent claim is really no different than for claim 1. The horizon is not an element of the claimed structure and is not geometrically defined by an element or elements of the claimed structure. Orientation with respect to an unclaimed element is an intended use, not a structural limitation upon the claimed structure. The apparatus of McNeilly would be capable of being tilted with respect to the horizon in any manner desired.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


David L. Sorkin

DAVID SORKIN
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